

Appl. No. 10/550287
Reply to Office Action dated 3/3/09 and Advisory Action dated 6/12/09

Remarks

Favorable reconsideration of this application is respectfully requested in view of the above amendments and following remarks. Claims 10 and 22 are amended to include subject matter from previously presented claims 25 and 28, which are supported for instance in Example 1 on page 16, line 12. Claims 23-28 are canceled without prejudice or disclaimer. Claims 29-35 are added and are supported, for instance in the original claims as filed, Figs 5A-B, and page 4 lines 22-26. No new matter has been added and Applicant respectfully request that the amendments and remarks herein be entered and considered along with the Request for Continued Examination filed concurrently herewith. Claims 10-11, 13, 16-17, 19-22 and 29-35 are pending.

Applicant appreciates the Examiner's courtesy in interviewing this application with Applicant's representative on June 18, 2009. During the interview, the Advisory Action dated June 12, 2009 was discussed with regard to the non-entry of the after final Amendment filed on June 3, 2009. Particularly, Applicant's representative questioned the non-entry of the claim amendments, since the independent claims 10 and 22 were amended to respectively include dependent claims 25 and 28 which were already of record and presumably considered. The Examiner and his Supervisor, however, concluded that the claim amendments as submitted would not be entered, and maintained as the basis for non-entry that the amendments change the scope of at least some of the claims. More particularly, the Examiner said that adding claim 25 into claim 10 changes the scope of the other claims that remain dependent on claim 10, because those combinations were not previously searched and considered. However, the Examiner said that the proposed claim 22 would be enterable since no other dependent claims would remain after adding claim 28 into claim 22, and further added that the amendment of claim 10 (adding claim 25) also would be enterable if the other remaining dependent claims were canceled. Applicant's representatives disagreed with the conclusion.

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Claims 10, 13, 16, 17, and 19-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-141686 in view of Stewart et al. (US 4,589,547), one of Heller et al. (US 6,143,164) and Mao et al. (US 6,605,201) and Feldman et al. (US 6,461,496). Applicant respectfully traverses the rejection for at least the following reasons.

Claims 10 and 22 are directed to a sensor-container combination. Claims 10 and 22 recite sensors that include a mediator that mediates transfer of electrons caused by oxidation or reduction, where the mediator is $[\text{Ru}(\text{NH}_3)_6]$. Claims 10 and 22 were amended to include this feature from the subject matter of claims 25 and 28, which are now canceled.

Applicant respectfully submits that, while the rejection includes previous claims 25 and 28, *prima facie* obviousness has not been shown with respect to this feature (now respectively incorporated into claims 10 and 22), because both the references and the rejection provide no showing to conclude that the feature is in the prior art.

Rather, the references cited do not disclose or suggest a mediator that is a ruthenium complex, namely $[\text{Ru}(\text{NH}_3)_6]$, having the particular nitrogen containing ligand. None of the references show the particular ruthenium complex claimed, and therefore fail to teach each and every feature of claims 10 and 22. Consequently, claims 10 and 22 are patentable over JP 2001-141686, Stewart et al., Heller et al., Mao et al., and Feldman et al. for at least these reasons. Claims 11, 13, 16, 17, and 19-21, which depend upon claim 10 also are patentable for the same reasons specified with respect to claim 10.

Favorable reconsideration and withdrawal of the rejection are respectfully requested.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 10, and further in view of either one of Yamamoto et al. (4,889,229) and Swain (US 3,139,976). Applicant respectfully traverses the rejection for at least the following reasons.

Claim 11 depends upon claim 10. Claim 11 is patentable over the art cited as applied to claim 10 above, for at least the same reasons specified above. With regard to Yamamoto et al. and Swain, these references fail to remedy the deficiencies of the art

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cited above, because the references at least do not disclose the particular mediator is [Ru(NH₃)₆]. Consequently, claim 11 does not follow from these references.

Favorable reconsideration and withdrawal of the rejection are respectfully requested.

Claims 24, 25, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art applied to claims 10 and 22, and further in view of Karinka et al. (US 2004/0079653). The rejection is rendered moot as claims 24, 25, 27, and 28 have been canceled. However, Applicant herein addresses Karinka et al. as to previous claims 25 and 28 since the subject matter of these claims are now respectively incorporated in the independent claims 10 and 22.

As with the previous references cited, Karinka et al. also fails to disclose or suggest use of the particular mediator [Ru(NH₃)₆] recited in claims 10 and 22. Rather Karinka et al. describes a formula for a complex cation, where ammonia (NH₃) can be used as some of the ligands (a, b, c, d), but not for all of the ligands. In fact, Karinka et al. requires that at least 1, 10-phenanthroline-5-6-dione is included as one of the ligands (see e.g. [0040] and [0041]). Thus, Karinka et al. fails to meet the limitations of claims 10 and 22, namely where the mediator is [Ru(NH₃)₆].

Moreover, Applicant respectfully submit that the claimed sensor-container combination, namely where the sensor includes the mediator [Ru(NH₃)₆] in combination with a partly transparent or semi-transparent container, was neither predictable in, nor reasonably suggested by, any combination of the art of record. Regardless of the sensors present at the time of Applicant's invention, Applicant has found that [Ru(NH₃)₆] has lightfastness and is desirable for such sensor-container products. For at least the foregoing reasons, Applicant respectfully submits that claims 10 and 22 and the respective dependent claims are patentable over the art cited.

Lastly, Applicant again kindly reminds the Examiner that Yamamoto et al. (US 4889229), which is applied in the current art rejections and was first applied in the Office Action mailed July 12, 2007, was incorrectly cited in the Form PTO-892 as the reference Sandish et al. (US 4889239). Applicant again respectfully requests that the Examiner

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issue a new PTO-892 correctly citing Yamamoto et al. Regarding the reference Lynch et al. (US 5447229 and cited in the rejections of the final Office Action mailed January 23, 2008), Applicant also again notes that the Form PTO-892 in the January 23 final Office Action does not list this reference. Applicant again respectfully requests that the Examiner issue a new PTO-892 citing Lynch et al.

Regarding added claims 29-35, Applicant respectfully submits that these claims are allowable for at least the same reasons as their respective dependent claims. Favorable consideration of these claims is also requested.

In view of the above amendments and remarks, Applicants respectfully request favorable reconsideration of this application in the form of a Notice of Allowance. If any questions arise regarding this communication, the Examiner is invited to contact Applicants' representative listed below.

Respectfully submitted,



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